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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,603	01/26/2005	Tsunehiro Fukuchi	2005-0024A	3410

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EXAMINER	
CHEN, CATHERYNE	

ART UNIT	PAPER NUMBER
1655	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/522,603	FUKUCHI ET AL.	
	Examiner	Art Unit	
	Catheryne Chen	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 January 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *Jan. 26, 2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-2 are pending.

Specification

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The composition in the form of jelly containing "Chinese herbal medicine" is indefinite because the metes and bounds of the claims are unclear. This term needs to be defined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ninomiya et al. (US 5932235). Ninomiya et al. teaches medical composition in a jellied form containing carrageenan, xanthan gum (column 1, lines 62-68). Carrageenan used includes kappa, iota, and lambda types (column 4, lines 17-18). Orange juice is rich in vitamin C, which is considered an herbal medicine (column 12, line 62). The composition does not contain phosphate buffer.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Aoi et al. (JP 4046937A). Aoi et al. teaches Chinese medicine mixed with a gelatinizing agent from carrageenan and a jelly without phosphate buffer (abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoi et al. (JP 4046937A) and Ninomiya et al. (see supra). Aoi et al. teaches Chinese medicine mixed with a gelatinizing agent from carrageenan and a jelly without phosphate buffer (abstract). Ninomiya et al. teaches xanthan gum, carrageenan with medicine (see supra).

These references show that it was well known in the art at the time of the invention to use the claimed ingredients in compositions to make a jelly. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that these substances are used in compositions to make a jelly, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating compositions to encompass Chinese medicine. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See In re

Sussman, 1943 C.D. 518; In re Huellmantel 139 USPQ 496; In re Crockett 126 USPQ 186.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takatsu (US 6703063 B2) in view of Young et al. (US 6048564) and Ninomiya et al. (see supra).

Takatsu teaches jellied black jujubes, which is a Chinese herbal medicine (column 2, lines 29-30, 66-67). However, it does not teach the claimed gelling agent.

Young et al. teaches xanthan gum, carrageenan, carob bean gum in a jelly (column 1, line 60; column 2, lines 21, 29-30).

Ninomiya et al. teaches using iota, kappa, and lambda carrageenan to gel medicinal compositions (column 4, lines 17-18).

Thus, an artisan of ordinary skill would reasonably expect that these gelling agents taught by Young et al. and Ninomiya et al. could be used as the types of gelling agent in the jellied composition of Takatsu. This reasonable expectation of success would motivate the artisan to use these gelling agents in the referenced composition. Thus, using these gelling agents is considered an obvious modification of the references.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugai et al. (US 6063366), in view of Young et al. (see supra) and Ninomiya et al. (see supra).

Sugai et al. teaches kudzu, Chinese medicine, in jelly (column 5, lines 26-27; column 7, line 62). However, it does not teach the claimed gelling agent.

Young et al. teaches xanthan gum, carrageenan, carob bean gum in a jelly (column 1, line 60; column 2, lines 21, 29-30).

Ninomiya et al. teaches using iota, kappa, and lambda carrageenan to gel medicinal compositions (column 4, lines 17-18).

Thus, an artisan of ordinary skill would reasonably expect that these gelling agents taught by Young et al. and Ninomiya et al. could be used as the types of gelling agent in the jellied composition of Sugai et al. This reasonable expectation of success would motivate the artisan to use these gelling agents in the referenced composition. Thus, using these gelling agents is considered an obvious modification of the references.

Conclusion

No claims are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catheryne Chen whose telephone number is 571-272-9947. The examiner can normally be reached on Monday to Friday, 9-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Catheryne Chen
Patent Examiner
Art Unit 1655

10-2-06

SUSAN COE Hoffman
PRIMARY EXAMINER